

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF KENTUCKY
CENTRAL DIVISION
AT LEXINGTON

Electronically Filed

iLOR, LLC,

Plaintiff,

v.

GOOGLE INC.,

Defendant.

Civil Action No. 5:07-cv-00109-JMH

**DEFENDANT'S MOTION TO DISMISS REMAINING CLAIMS
AND COUNTERCLAIMS WITHOUT PREJUDICE, AND FOR ENTRY OF FINAL AND
APPEALABLE JUDGMENT**

In the Opinion and Order dated November 30, 2007, this Court: (1) denied Plaintiff's motion for preliminary injunction (Document No. 12), (2) granted Defendant's cross-motion for summary judgment of non-infringement (Document No. 52), and (3) dismissed with prejudice Plaintiff's claims against Defendant in this action. The Judgment entered in this action on November 30, 2007 also stated that the entirety of this action was dismissed with prejudice, and struck from the active docket.

At the hearing on November 19, 2007, counsel for Plaintiff represented without reservation that Plaintiff would cease to exist, in December of 2007, if its request for a preliminary injunction were denied (Tr. 8:25-9:2):

Mr. Schmidt: ... Without this injunction – and this is an undisputed fact – iLOR will be dead next month, in December of 2007. It will have run out of money.

Indeed, Plaintiff's impending and certain demise was at the heart of its request for the extraordinary relief of a preliminary injunction.

Notwithstanding this unequivocal representation, iLOR was very much alive on December 31, 2007, and on that day noticed an appeal of the Court's November 30, 2007 decision.¹ That notice was premature, because the case was not yet ripe for appeal. Although

¹ Plaintiff's website, <http://www.pfoundblog.com/>, is also still up and running.

the November 30, 2007 Judgment appeared to dismiss the entire action with prejudice, the only claim disposed of by the November 30, 2007 Opinion and Order is Plaintiff's claim for infringement. Defendant has presented counterclaims in this action, including declaratory judgment counterclaims for invalidity and unenforceability based on inequitable conduct, which remain unresolved. (Document 47, at 5-6.) In order to put this case in condition for appeal, all of Defendant's remaining counterclaims must be disposed of, and judgment then entered. *See, e.g., Nystrom v. TREX Co.*, 339 F.3d 1347, 1351 (Fed. Cir. 2003) ("A 'judgment that does not dispose of pending counterclaims is not a final judgment.'"); *Pause Tech. LLC v. TiVo Inc.*, 401 F.3d 1290 (Fed. Cir. 2005) (decision granting defendant's motion for summary judgment of non-infringement was not a final appealable decision where the defendant's invalidity declaratory judgment counterclaims remained unresolved); *Enzo Biochem, Inc. v. Gen-Probe Incorporated*, 424 F.3d 1276 (Fed. Cir. 2005) ("Because Gen-Probe's unenforceability counterclaim remains adjudicated in the district court, the present appeal is not from a final decision within the meaning of 28 U.S.C. § 1295(a)(1).").

It is Plaintiff's burden to ensure that the judgment it appeals from is final.² *See* Federal Circuit Rule 28(a)(5) (requiring appellant to represent that the judgment or order appealed from is final, or excepted from the final judgment requirement). Given iLOR's repeated assertions that it would cease to exist if its preliminary injunction motion were denied, it certainly appeared that no appeal would be taken from the Court's November 30, 2007 Opinion and Order. However, given Plaintiff's apparent change of circumstances, or tactics, Defendant hereby moves to dismiss all of its remaining counterclaims, without prejudice to reinstituting such counterclaims following the disposition of the appeal of this case to the Court of Appeals for the Federal Circuit, and asks the Court to thereafter (or concomitantly) re-enter judgment on the basis of the fully resolved action.

Dated: January 9, 2008

² Defendant first raised this jurisdictional defect with Plaintiff by voicemail on January 4, 2008. Plaintiff refused to stipulate to the relief sought by the present motion, and declined to provide any explanation for its refusal.

Respectfully submitted,

s/James R. Higgins, Jr.

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CERTIFICATE OF SERVICE

It is hereby certified that I electronically filed the foregoing Corporate Disclosure Statement with the clerk of the court by using the CM/ECF system, which will send a notice of electronic filing to the following:

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